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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,513	02/04/2005	Peter Dolling	2002P09934WOUS	1286

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

NORTON, JENNIFER L

ART UNIT	PAPER NUMBER
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2121

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/523,513

Applicant(s)

DOLLING ET AL.

Examiner

Jennifer L. Norton

Art Unit

2121

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 15-33.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

DAVID VINCENT 11/17/08
SUPERVISORY PATENT EXAMINER

Continuation of 13. Other: Applicant's arguments, see Remarks pgs. 6-8, filed 09 January 2008 with respect to the rejection of claims 32 and 33 under 35 U.S.C. 102(b) and 15-31 under 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

Applicant's proposed amendment to claim 19 will not be entered because it further narrows the scope of the claim limitations of claim 15, hence the amendment does not materially reduce or simplify the issues for appeal.

In regards to Applicant's argument that PCT Application No. PCT/US00/14590 (hereinafter Gundmudsson) nor U.S. Patent No. 5,880,959 disclose, "a first navigation area, a second navigation area and a data area"; the Examiner recognizes the Applicant has not accounted for the combination of Gundmudsson and Shah, incorporated by reference in Gundmudsson under 35 U.S.C 102(b) for this limitation as set forth in the Final Office Action mailed on 14 November 2007.

With respect to the Applicant's arguments that the prior art fails to disclose, "design of an installation"; the Examiner respectfully disagrees.

Gundmudsson discloses (pg. 5, lines 14-19) "For one embodiment, the computer aided design tools include tools used for computer-based design, testing, verification and implementation of a system or components of a system. Examples of systems and system components include, but are not limited to, process and equipment controllers, signal processing equipment, communication devices, process monitors, fault detection systems, and computer hardware and software."

Shah discloses (col. 1, lines 5-9) "The present invention is in the field of methodologies for engineering design activities, and more particularly in the field of methodologies for computationally intensive signal processing design or control system design activities."

With respect to the Applicant's arguments, "Clearly, the references disclose different embodiments and the mere fact that Gundmudsson incorporates Shah by reference does not give license to pick features from each reference as though they were both part of the same embodiment."; the Examiner respectfully disagrees. See MPEP 2163.07(b) [R-3] recited below for convenience:

MPEP 2163.07(b) [R-3]:

Incorporation by Reference

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter. See >37 CFR 1.57 and < MPEP§ 608.01(p) for Office policy regarding incorporation by reference.

With respect to claims 15-31, Applicant's argument that the prior art does not teach "the second navigation area", "data area", "the feature of subtasks or work tasks "performed in the data area ... to select a data option..." and "sub-tasks and work steps associated with designing the project are simultaneously displayed ...", the Examiner recognizes the Applicant has not accounted for the combination of Gundmudsson and Shah, by incorporation of Gundmudsson in view of U.S. Patent 5,631,825 (hereinafter Van Weele) under 35 U.S.C 103(a) for these limitations as set forth in the Final Office Action mailed on 14 November 2007.

Hence, the rejection of claims 15-33 stand rejected as set forth in the Final Office Action mailed on 14 November 2007.